

REMARKS

The present application contains claims 1-7, 10-16 and 31-37.

Applicants have amended the Abstract of the present application.

Applicants have amended claims 1, 2, 4, 6-7, 10-11, 13, 15-16; and added claims 31-37 to a scope commensurate with the support of the specification. Applicants have canceled claims 8-9, 17-30 without prejudice or disclaimer. The amendment to the claims is fully supported by the application as originally filed. Support for the amendment of the claims can be found, for example, on page 3, line 6, and page 4, line 12 of the present application.

In the Office Action, the Patent Office has rejected claims 1, 27-30 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended claim 1 merely for purposes of clarification. Applicants submit that claim 1, as amended, particularly point out and distinctly claim the subject matter, as required by 35 U.S.C. 112, second paragraph. Applicants have cancelled claims 27-30 without prejudice or disclaimer, thus rendering the Patent Office's rejections to these claims moot.

Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. 112.

The Patent Office has rejected claims 1, 3, 5-10, 12, 14-30 under U.S.C. 102 (e) as allegedly being anticipated by Levin (U.S. Patent No. 6,130,882), hereinafter referred to as Levin.

Claims 8, 9, and 17-30 have been cancelled, thus rendering the Patent Office's rejection to these claims moot. Applicants respectfully traverse the rejection to the extent such rejection may be considered applicable to the amended claims. Amended claims 1 and 10 recite the features of:

determining and storing on a per bin basis channel frequency response and noise measurements at a first end of the channel at

initialization;

[...]

receiving data at the second end at a rate in dependence upon the retrieved measurements.

Levin does not teach or suggest the determination of the channel frequency response on a per bin basis, and the reception of data based on the combined, retrieved measurements. As stated on page 6, lines 1 to 5: “The combination of complete information on the channel ($H(f)$ and $N(f)$) during initialization plus show time $SNR(f)$ [...] allows greater analysis of the line conditions than known methods and reduces interruptions of both the ADSL and POTS service that known methods require.”

Levin fails to disclose each and every feature of the claimed invention, as required by 35 U.S.C. 102(e), and provides no teaching that would have suggested the desirability of modification to include such features.

Accordingly, Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. 102.

The Patent Office has rejected claims 2, 4, 11, and 13 under 35 U.S.C. 103(a) as allegedly being unpatentable over Levin and in view of Strait (US Patent No. 6,266,367), hereinafter referred as Strait.

Applicants have amended claims 2, 4, 11, and 13 to further include the features for the first end and the second end of the channel. Support for the amendment can be found, for example, at page 3, lines 6 to 21 of the present application. Applicants respectfully submit that the amended claims 2, 4, 11, and 13 are patentably distinguishable over the combination of Levin and Strait.

Additionally, according to established mandates of the patent laws, “[t]o establish a prima facie case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” [M.P.E.P. § 2142] “There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and

the knowledge of persons of ordinary skill in the art.” [M.P.E.P. § 2143.01] “The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved.” [*In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000)] The showing must be “clear and particular, and it must be supported by **actual evidence.**” [*Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 1334, 63 U.S.P.Q.2d 1374, 1387 (Fed. Cir. 2002) (quoting *In re Dembicza*k, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999)) (emphasis added)] It is not sufficient to rely on “common sense and common knowledge,” as there must be specific evidence to support the motivation. [*See In re Lee*, 277 F.3d. 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1434-35 (Fed. Cir. 2002)]

It is respectfully submitted that the Patent Office has made no showing of a motivation to combine based on actual, specific, evidence. The Patent Office’s alleged motivation is simply a naked assertion, unsupported by any actual, specific, evidence. Consequently, it is respectfully submitted that the Patent Office has not established a *prima facie* case of obviousness.

Rather, according to M.P.E.P. § 2142, “[t]o reach a proper determination under 35 U.S.C. 103, . . . impermissible hindsight must be avoided and the legal conclusion [of obviousness] must be reached on the basis of the facts gleaned from the prior art.” Furthermore, according to M.P.E.P. § 2143.01, “[t]he mere fact that references can be . . . modified does not render the resultant combination obvious unless the prior art also suggests the desirability of [such modification].” [*citing In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)] Since the Patent Office has offered no proper support or motivation for combining the references, it is respectfully submitted that the rejection based on obviousness is clearly and unequivocally founded upon “knowledge gleaned only from applicant’s disclosure.” [*see M.P.E.P. § 2145*] Consequently, it is respectfully submitted that the rejection entails hindsight and is, therefore, improper.

Applicant respectfully requests reconsideration of this application, based on the foregoing amendments and remarks.

All of the objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance and a notice to that effect is earnestly solicited. Should the Examiner have any questions regarding this amendment or the application in general, the Examiner is urged to contact the Applicants' attorney, Richard P. Bauer, by telephone at (202) 625-3507. All correspondence should continue to be directed to the address given below.

Respectfully submitted,

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